



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,197	10/16/2000	Douglas A. Collins	COP1001	2254

7590 06/11/2002

Sherry M Knowles
King & Spalding
191 Peachtree Street NE
45th Floor
Atlanta, GA 30303

EXAMINER

LUKTON, DAVID

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/11/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/690,197	Applicant(s) Collins
Examiner David Lukton	Art Unit 1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Mar 21, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4) Claim(s) 1-53 and 65-71 is/are pending in the application.

4a) Of the above, claim(s) 69-71 is/are withdrawn from consideration.

5) Claim(s) 2-8, 13-23, 25-42, 44-49, 51-53, and 65-68 is/are allowed.

6) Claim(s) 1, 9-12, 24, 43, and 50 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12

4) Interview Summary (PTO-413) Paper No(s). _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Pursuant to the directives of paper No. 11 (filed 3/21/02), claims 108, 24-27, 29-31, 33-35, 40, 41, 53, 65, 66, 68 have been amended. Claims 1-53, 65-71 remain pending.

Applicants' arguments filed 3/21/02 have been considered and found persuasive in part. The rejection of claim 68 under §112, first paragraph is withdrawn (because of deletion of the term "pharmaceutical") as is the rejection of claim 1 over Primus (*Bioconjugate Chem* 7, 532, 1996).

*

Claims 9, 24, 43 and 50 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Each of claims 9, 43 and 50 employ the term "about" in reference to a range. For example, claim 9 recites that the molecule which contains B10 contains "about" one to "about" 20 boron atoms. Use of the term "about" in reference to a range renders the claims indefinite. Especially puzzling is the issue of which numbers might be encompassed by "about one". Does this include zero?
- Claim 24 requires a structural feature which is not required by claim 1. Accordingly, either claim 1 should be amended to recite the possibility of a linker (comprising a detectable or therapeutic radionuclide), or else claim 24 should be made independent.

*

The following is a quotation of 35 USC §103 which forms the basis for all obviousness

rejections set forth in the Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claims 1 and 9-12 are rejected under 35 U.S.C. §103 as being unpatentable over Collins (USP 6,004,533) in view of Schinazi (USP 5,599,796).

Collins discloses compounds in which cyanocobolamin is linked to a diagnostic radionuclide. Collins does not disclose compounds in which cyanocobolamin is linked to boron-10. Schinazi discloses compounds containing boron-10 in which cyanocobolamin is linked to boron-10. Schinazi does not disclose that one of those compounds bearing B10 should be cyanocobolamin. However, it would have been obvious to one of ordinary skill to link B10 to cyanocobolamin to achieve the therapeutic benefits asserted by Schinazi.

Serial No. 09/690,197
Art Unit 1653

-4-

References "AO" and "AR" were stricken from the IDS because of the absence of a translation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1600